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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,751	05/25/2000	Theodore Jack London Shrader	AUS000168US1	6562

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,751

Applicant(s)

SHRADER ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Applicants' amendment filed March 16, 2005 is acknowledged. Accordingly, claims 1-14 remain pending.
2. After further review of this application and after discussions with the Examiner's supervisory primary examiner, the finality as set forth in the "Third Final Office Action" mailed June 3, 2005 is hereby withdrawn. Unless expressly withdrawn, the Examiner maintains all other factual findings and legal conclusions as set forth in the Third Final Office Action.
3. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
4. This Office Action, the "Forth Final Office Action" is given Paper No. 20060104.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §112 2nd Paragraph

6. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-9 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 1, it is unclear if the newly added “including” in line 9 modifies “record or “computer.”
- b. Claim 6 is indefinite because the metes and bounds of the claim can not be determined. In particular, it is unclear if the phrase “wherein the profile includes matching criteria that must be met for the item name” in claim 6 is ‘in addition to,’ or ‘in replacement of,’ the phrase “generating a profile” as recited in claim 1. First, the Examiner starts with the presumption that all claim terms are presumed to have meaning in a claim. “While not an absolute rule, all claim terms are presumed to have meaning in a claim.” *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1119, 72 USPQ2d 1001, 1007 (Fed. Cir. 2004). Second, the Examiner adapts the presumption that there exists a difference in meaning and scope when different words or phrases are used in separate claims. “The doctrine of claim differentiation can shed light on the proper scope to be afforded a claim limitation, for there is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims.” *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 53 USPQ2d 1065, 1070 (Fed. Cir. 1999) citations and quotations omitted). In this case, Applicant clearly uses “further including” in claims 2 and 3. Because claim 6 does not use “further comprising” or other phraseology in the preamble indicating they desire the subsequent limitations to be ‘additional’ limitations, and because Applicants’ use “further comprising in other claims, claim 6 has the presumption that it does not contain “further” limitations.

Because it does not contain additional or further limitations, it remains unclear if “the profile includes matching criteria that must be met for the item name” in claim 6 is ‘in addition to,’ or ‘in replacement of,’ the phrase “generating a profile” as recited in claim 1. Yet because the presumption has been established that the claim is interpreted to mean ‘in addition to,’ the only remaining interpretation is ‘in replacement of.’

Claim Rejections - 35 USC §102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-14, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Streetprices.com (website printout of January 25, 1999) (“Streetprices 1/99”). Streetprices 1/99 discloses generating a set of product profiles (see *e.g.* “Computers”, “Flowers” and “Toys”), each identifying a given site URL (inherent); a list of one or more included items to be queried (the product to be searched), a scan interval (inherent in the graphs) and a site template (inherent in HTML and XML; periodically retrieving data from the given site URL (inherent in the x axis of the graph) according to the scan interval; parsing the data retrieved to generate a data record (inherent since it discloses the price over time); storing the

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data records (inherent); and the product profiles includes one or more triggers (a threshold price which sends an email when a price drops below a particular level).

Claim Rejections - 35 USC §103

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-14 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Streetprices 1/99 in view of Bailey et. al. (U.S. 6,785,671)(“Bailey”), Muller’s Desktop Encyclopedia of the Internet (“Muller”), and Gralla’s How the Internet Works (“Gralla”).¹ It is the Examiner’s principle position that the claims are anticipated because the parsing is inherent and a profile identify a given a site URL is also inherent.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Streetprices 1/99 as taught by Bailey to include Bailey’s parsing. Such a modification would have simply disclosed a feature that is already inherent in Bailey.

Regarding the generating the profile identifying a given site URL, this too is inherent in web crawler program. If web crawler programs does not generate an object, list, or profile identifying a given URL, that particular URL can not be searched.

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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12. In this particular rejection, Muller and Gralla are cited simply to show those features of the Internet that are old and well known in the art yet silent in Streetprices 1/99 and Bailey.

13. Additionally, if the sever structure was not inherent, it too would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Streetprices 1/99 to include generating at the client computer a profile. It is the Examiner's position that absent evidence of new or unexpected results, it is not inventive in terms of patentability to take one or more clients or servers ($S_1, S_2, S_3, \dots S_N$) which perform one or more tasks ($T_1, T_2, T_3, \dots T_N$) and add (or subtract) an additional number of servers (X) to perform all or part of the same tasks by allocating the tasks between the various clients and servers (*i.e.* S_1 and S_{N+1} perform T_1 ; S_2 and S_{N+2} perform T_2 ; S_3 and S_{N+3} perform T_3 ; ... while S_N and S_{N+X} perform T_N). The prior art is replete with examples showing why user various client server configurations are desirable.²

14. In other words, a modification distributing the tasks between various clients and servers (*e.g.* having a client computer perform a task previously performed by one or two servers) is analogous to making functions, structures, or actions separable. It is the Examiner's position that

² See *e.g.* Watson (U.S. 6,223,209 B1) disclosing distributed satellite world wide web servers containing identical information placed strategically throughout the Internet so as to be close to all potential clients to help reduce traffic bottlenecks; Midgely et. al. (U.S. 5,592,611 A) disclosing additional servers as a stand-in for a failed server so that client service requests are transparent to the user; Kriegsman (U.S. 6,370,580 B2) disclosing multiple servers as secondary web servers to optimize file transfers; Burns et. al. (U.S. 6,298,373 B1) disclosing cache servers which download content during off-peak hours to reduce traffic bottlenecks; Stiles (U.S. 6,219,692 B1) which discloses sending essentially identical tasks to multiple servers with differing processing loads to find the most preferred server provider; Zdepski et. al. (U.S. 5,825,884) disclosing an transactional server for TV networks; Burns et. al. (U.S. 6,298,373) disclosing how computers are used at clients to increase bandwidth by providing content in downloaded from other computers; *How Networks Work*, Chapter 17 describing how sever based structures benefit from economies of scale in addition to offering security, excellent data management, fast response, and room for expansion; and *How the Internet Works*, Chapter 44 implementing a server based architecture in Internet e-commerce.

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when the difference between the claimed invention and the prior art is that the prior art does not disclosed an element as separable, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element separable. See MPEP §2144.04 V. C. and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). As noted above, it is desirable to allocate the computer tasks to various clients and servers to help reduce bandwidth bottlenecks and to help increase the benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion.

15. After careful review of the entire record, especially the specification, the Examiner finds that Applicants have not asserted in their specification any new or unexpected results regarding their hardware configuration (i.e. using the “client computer”). Absent such new or unexpected results, such modifications having either servers or client computers perform tasks or even reassigning tasks to different server(s) or client computers would have helped maintain benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs.

16. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.³ First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants

³ See the First Non Final Office Action mailed July 29, 2003, Paper No. 9, Paragraph No. 17; the First Final Office Action mailed November 6, 2003, Paper No. 11, Paragraph No. 12; the Second Final Office Action (finality withdrawn) mailed September 30, 2004, Paragraph No. 26.

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not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements⁴ with the required clarity, deliberateness, and precision.⁵ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁶ Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation⁷ to be their own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicants have

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁶ See Note 3.

⁷ See *Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

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decided not to be their own lexicographer. Therefore, the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁸

Response to Arguments

17. Applicants' arguments filed March 16, 2005 have been fully considered. While some are persuasive, other are not.

18. Applicants amendments have overcome the §101 rejections.

19. Because Applicants have supplied evidence in the form of a dictionary definition and a U.S. patent (*i.e.* Elliott Jr. et. al., U.S. 5,214,653), the Examiner adopts Applicants' definition as found on page 6 of their Remarks (filed March 16, 2005) as the broadest reasonable interpretation for the term 'fuzzy logic.'

20. Applicants' arguments with respect to claim 6 are not persuasive.

21. Applicants next argue that Streetprices 1/99 is a server and not a client computer. The Examiner respectfully disagrees. Based on the definitions provided by the Examiner in the First Non Final Office Action (mailed July 29, 2003), Page 11, Paragraph No. 18a, it is the Examiner's position that one person's 'server' computer is another person's 'client computer.' Because Applicant's specification does not offer new or unexpected results of the client

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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computer performing the actions instead of the server computer, such a difference is insufficient to distinguish the claims over the prior art.

22. The Examiner finds that based upon all evidence of record, Streetprices 1/99 need not be a single server. As noted above, there are many reasons for having various client server configurations.

23. The Examiner maintains his position that inherently disclosed elements, like directly disclosed elements, must be shown by the Examiner by a preponderance of the evidence.

24. Applicants arguments regarding 'robots' are not persuasive.

25. Applicants argue that "there is no evidence whatsoever that a product profile is generated in Streetprices 1/99."⁹ The Examiner disagrees. Since the smallest amount of evidence will negate Applicants arguments that "there is no evidence whatsoever," the Examiner relies on the product identifier as 'some evidence.' Applicants' arguments have therefore been considered but are not persuasive. To be clear, Applicants have failed to argue whether the evidence is 'sufficient' (*i.e.* based upon a preponderance of the evidence) that the product profile is generated in Streetprices 1/99. Because Applicants have failed to argue that the evidence is insufficient, the Examiner will therefor not address whether the evidence is sufficient in the "Response to Arguments" section. To be especially clear, Applicants argue "there is no evidence whatsoever" By the Examiner providing at least *some* evidence (and because 'some evidence' is greater than "no evidence whatsoever"), Applicants' arguments are not persuasive.

26. The Examiner is unsure what Applicants intend by the phrase "termination of prosecution." The Examiner has reviewed MPEP §707.02. Applicants are reminded that it is a

⁹ Applicants' Remarks filed March 16, 2005, Page 10, last ¶.

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patent applicant who control the fate of every application. Whether or not an application is 'terminated' is a decision for the patent applicant—not an examiner

This is because an examiner has no discretion as to whether or not to issue a patent application. "There is no discretion on the part of the PTO as to whether or not to grant the patent—if the statutory requirements are met, a patent is issued. 35 U.S.C. Section 151. *Markman v. Westview Instruments*, 52 F.3d 967, 34 USPQ2d 1321, 1334, n. 14 (Fed. Cir. 1995) (en banc), *aff'd*, *Markman*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). In other words, if an applicant complies with all statutes and rules, the examiner will issue the case. If an applicant does not comply, the procedures are set forth in the statutes, rules, and MPEP. While it is true examiners retain certain discretionary procedural decisions, substantive decisions of patentability are not discretionary and therefore can not be controlled by an examiner.

27. If Applicants' "termination of prosecution" is intended to mean either abandonment or appeal, Applicants must again make that decision. It is impossible for the Examiner to initiate appeal or an express abandonment.

Regarding Indefiniteness Under 35 USC §112 2nd Paragraph¹⁰

28. First, the Examiner notes that the primary purpose of the definiteness requirement is to provide notice. “The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction.” *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

29. Second, it is the Examiner’s position that during ex parte examination, if a claim in a utility patent application is indefinite on its face, the claim is indefinite. “If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted).

30. Third, if a claim is indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to completely and accurately construe claim of the claim. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these

¹⁰ Because this application has now been at least twice rejected and is therefore eligible for appeal to the USPTO’s Board of Patent Appeals and Interferences (“Board”), because of recent decisions by the Board and the Board’s position on indefiniteness, and in order to help and enable Applicant(s) to craft reasoned arguments should Applicant(s) eventually decide to appeal an indefiniteness rejection to the Board, the Examiner has provided the following discussion on 35 USC §112 2nd Paragraph and indefiniteness.

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claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

31. Forth, the Examiner recognizes that breath of a claim is not be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). However, “[i]f the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” MPEP §2173.02 citing *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). In other words, claim breath indicates the range or scope a claim limitation covers while the metes and bounds indicate where the claimed subject matter begins and ends. These are two principles are distinct and separate principles. A broad claim—like a narrow claim—may or may not have clear metes and bounds and thus may or may not be definite. Thus, if a person of ordinary skill in the art could not interpret the metes and bounds of a claim—even a broad claim—so as to understand how to avoid infringement, the claim is indefinite as well as broad.

32. Fifth, a claim in a utility patent application is either indefinite under 35 U.S.C. §112, 2nd paragraph or it is not. Contrary to recent decisions of the USPTO’s Board of Patent Appeals and Interferences (“Board”), the law does not recognize a ‘scale’ or ‘range’ of indefiniteness such as ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite.’ There is no middle ground since at the end of the day, ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite’ are nevertheless *still indefinite*. The Examiner frequently receives arguments from applicants and decisions from the Board where the parties respectively argue that ‘the examiner knows what is meant by the term’ or ‘the language is clear from the specification.’ However these arguments

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can not overcome claim language that is indefinite on its face. In other words, “semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]” *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).¹¹ Again, so as to be especially clear, a claim is either indefinite—or it is not indefinite. When the claim is indefinite, the claim by definition, can not be construed. And if the indefiniteness is rendered during ex parte examination, neither the specification nor the prosecution history can be used to rectify the indefiniteness.¹²

33. Sixth, the Examiner recognizes that “compliance with Section 112 Para. 2 is a question of law.” *In re Dossel*, 115 F.3d 942, 944, 42 USPQ2d 1881, 1883 (Fed. Cir. 1997). Additionally, when questions of indefiniteness arise, we use general principles of claim construction. “In the face of an allegation of indefiniteness, general principles of claim construction apply.” *Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 75 USPQ2d 1801, 1805 (Fed Cir. 2005) citing *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1340–41, 65 USPQ2d 1321, 1326 (Fed. Cir. 2003) (noting that a determination of definiteness “requires a construction of the claims according to the familiar canons of claim construction”). However, a patent claim that is

¹¹ As a practical matter, a patent applicant virtually always has an opportunity to correct indefiniteness by filing either an amendment to a non final office action, or alternatively if in response to a final office action, a request for continued examination under 37 C.F.R. §1.114 along with an amendment.

¹² Compare *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001) vs. *In re Jolly*, 172 F.2d 566, 80 USPQ 504 (CCPA 1949). In *Exxon Research*, the Court of Appeals for the Federal Circuit reviewed “similar claim language” as was interpreted in *Jolly* (where the language in question was held to be indefinite) and held that for purposes of indefiniteness, claims are interpreted differently during ex parte examination than the same claim phases during inter parte litigation.

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indefinite on its face can not be rendered 'definite' by a reviewing body simply because the result would otherwise be inequitable or unfair to applicant, because the result would be too harsh or severe since it might result in the patent application becoming abandoned, or because rendering the claim indefinite is against a noble yet ill-conceived policy. "Claim construction, however, is not a policy-driven inquiry. As stated earlier, it is a contextual interpretation of language. The scope of patent claims can neither be broadened nor narrowed based on abstract policy considerations regarding the effect of a particular claim meaning." *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 70 USPQ2d 1737, 1742-43 (Fed. Cir. 2004) (quoting *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1584, 36 USPQ2d 1162, 1168 (Fed. Cir. 1995) ("[I]t is well settled that no matter how great the temptations of fairness or policy making, courts do not redraft claims"), *vacated on other grounds by* 403 F.3d 1328, 74 USPQ2d 1396 (Fed. Cir. 2005)(en banc).

34. Seventh, should Applicants appeal this application and should the Board have any questions regarding indefiniteness under 35 U.S.C. §112, 2nd paragraph and its application during ex parte examination when compared with inter parte litigation, the Examiner respectfully requests the Board to remand this application to the Examiner in order to provide additional guidance.

35. The Examiner concludes this section by reiterating that during ex parte examination, when a patent claim is rejected for indefiniteness because the claim is indefinite on its face, the claim can not be construed. In such a case, the application of prior art by an examiner or the Board is immaterial. Yet in order to avoid piecemeal examination, MPEP §2173.06 states that even if the examiner takes a position that a claim is indefinite, it is USPTO policy to nevertheless make an attempt at application of the prior art. However, neither this policy decision as set forth

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in MPEP §2173.06 nor even *any* policy decision by the USPTO can change the substantive standard for indefiniteness and thus the standard for a 35 U.S.C. §112 2nd paragraph rejection.¹³ So no matter how slight the indefiniteness may be, no matter how equitable applicant's arguments may seem, and no matter how great the temptations of fairness or policy making may appear to the Board, during ex parte examination, if a claim is indefinite on its face, the claim is just that—indefinite.

Conclusion

36. Applicants' amendment filed March 16, 2005 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

¹³ See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1559, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (“As we [the Federal Circuit] have previously held, the broadest of the PTO’s rulemaking powers—35 U.S.C. Section 6(a)—authorizes the Commissioner to promulgate regulations directed only to ‘the conduct of proceedings in the [PTO]’; it does not grant the Commissioner the authority to issue substantive rules.”).

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

Unless expressly noted otherwise by the Examiner using appropriate designations on form PTO-892, all references listed on form PTO-892 are cited in their entirety.

38. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

40. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a

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claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

41. Additionally, Applicants are reminded that it is inappropriate for the USPTO to disregard any relevant evidence. “It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) (“All the evidence on the question of obviousness must be considered.”); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]”); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002)(“Patentability vel non is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual

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determination by the USPTO that does not consider *all* relevant evidence may not be supported by substantial evidence¹⁴ since the particular evidence *not* considered may be probative of a factual issue presented. Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, and because any evidence *not* considered by the USPTO may be probative of at least one factual issue presented, Applicants are hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art. *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

42. Applicants are reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice

¹⁴ Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).

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that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the one or more of the reference(s) of record, Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants' response must also state *why* they either do not understand or have difficulty comprehending the one or more of the reference(s). If after properly receiving (*i.e.* Applicants' response is made of record) both Applicants' request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner. For all documents or references made of record after this Office Action, Applicants are given actual notice that this paragraph becomes effective when Applicants receive notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicants submits an Information Disclosure Sheet or when Applicants receive an examiner' Notice of References Cited (Form PTO-892).

43. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks

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Applicants for their "Remarks" (beginning on page 5) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁵ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (571) 272-6788. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
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AJF
January 4, 2006

¹⁵ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.